UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,557	01/02/2002	Christian Kraft	042933/299170	7117

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EXAMINER
KE, PENG

ART UNIT	PAPER NUMBER
2174	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/936,557	KRAFT, CHRISTIAN
	Examiner	**Art Unit**	
	Peng Ke	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>21 March 2007</u>.

2a) ☒ This action is **FINAL.**   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *15-57* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *15-57* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

This action is responsive to communications: Amendment, filed on 3/21/07.

This action is made Final.

Claims 15-57 are pending in this application. Claims 15, 16, 25, 29, 30 and 39 are

independent claims. In the amendment, claims 46-57 were added.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15, 29, 39, 40, 43, 45, 46, 49 and 51 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Deluca et al., International Publication No. WO 97/19429 in view of

Mochizuki US Patent 6,044,248 further in view of Miller US Patent 6,421,707.

As per claim 15, Deluca teaches a method for handling messages transmitted between

communication terminals via a wireless network comprising:

generating a compound message including a text part and at least one graphical icon part,

(see page 5, lines 13-14; Examiner interprets the image generated by the text #07 to be an icon)

the compound message generation including reading a user inputted text part (see page 5,

lines 13-21; Examiner interprets "#07Tom?" to be a compound message) and

converting the inputted text part into a predefined message text format, (see page 10,

lines 15-22; Examiner interprets the house address and the telephone number to be predefined

text messages because they are automatically generated based on upon user selection)

transmitting of the message via the wireless network (see page 3, lines 2-15; Examiner

interprets radio communication network to be a wireless network).

However, Deluca fails to teach adding graphical part to the message, the graphical part

including a record for each of the at least one graphical icon part in a graphical format;

and adding position information in the message defining a position of the at least one

graphical icon part in the text part.

Mochizuki teaches adding graphical part to the message, the graphical part including a

record for each of the at least one graphical icon part in a graphical format; (column 4, lines 63-

column 5,lines 8)

and adding position information in the message defining a position of the at least one

graphical icon part in the text part (column 5, lines 6-20)

It would have been obvious to an artisan at the time of the invention to include

Mochizuki's teaching with method of Deluca in order to allow users to send customized

formatted message.

However, Both Deluca and Mochizuki both fail to teach graphical icon part is in a

graphical format.

Miller et al. teaches transmitting messages that include graphical image. (column 1, lines

38-70)

It would have been obvious to an artisan at the time of the invention to include Miller's

teaching with method of Deluca and Mochizuki in order to allow users to transfer image files.

(see Miller; column 1, lines 31-35)

As per claims 29 and 39, they are rejected with the same rationale as claim 1. (see rejection above)

As per claim 40, which is dependent on claim 15, Deluca, Mochizuki, and Miller teach method of claim 15. Mochizuki further teaches wherein the position information further defines the position of the at least one graphical icon part relative to the text part such that at least a portion of the text is positioned prior to the at least one graphical icon part and at least another portion of the text part is positioned following the at least one graphical icon part. (see Mochizuki, figure. 9 (a-d), column 5, lines 6-20)

As per claim 43, which is dependent on claim 29, it is of the same scope as claim 40. Supra.

As per claim 45, which is dependent on claim 39, it is of the same scope as claim 40. Supra.

As per claim 46, which is dependent on claim 15, Deluca, Mochizuki, and Miller teach method of claim 15. Miller further teaches at least one graphical icon part comprises at least one of an image or a picture. (see Miller; column 1, lines 31-35)

As per claims 49 and 51, they are of the as same scope as claim 46.

Claims 52, 55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deluca et al., International Publication No. WO 97/19429 in view of Mochizuki US Patent 6,044,248 further in view of Miller US Patent 6,421,707 further in view of Sugio et al. US 6,032,025.

As per claim 52, which is dependent on claim 15, Deluca, Mochizuki, and Miller teaches method of claim 15. They fail to teach graphical part comprises an animation sequence.

Sugio teaches graphical part comprises an animation sequence. (see Sugio, column 42, lines 19-22)

It would have been obvious to an artisan at the time of the invention to include Sugio's teaching with method of Deluca, Mochizuki, and Miller in order to allow users to transfer animation sequences.

As per claims 55 and 57, they are of the as same scope as claim 46.

Claims 16, 19-25, 30, 33-38, 41, 42, 44, 47, 48, 50, 53, 54, and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugio et al. US 6,032,025 in view of Mochizuki US 6,044,248 further in view of Miller US Patent 6,421,707.

As per claim 16, Sugio teaches a communication terminal for handling messages and comprising:

a controller,

a transceiver for communicating with a wireless communication network, and

a user interface through which the user operates the terminal, the user interface including a display (see Sugio, column 2, lines 30-50),

message editor application allowing the user to generate a compound message including a text part and at least one graphical icon part; (see Sugio, column 2, lines 30-42 and column 7, lines 29-60) and

wherein the controller generates the compound message for being transmitted via the transceiver (see Sugio, column 2, lines 34-36) including

a text part in a predefined message text character format (see Sugio, column 7, lines 41-42),

However, Sugio fails to teach information in the message defining a position of the at least one graphical icon part in the text part.

Mochizuki teaches information in the message defining a position of the at least one graphical Icon part in the text part. (see Mochizuki, column 5, lines 6-20)

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate the method of Mochizuki with the method of Sugio in order to allow more user control over used screen space.

However, Both Deluca and Mochizuki both fail to teach a graphical part including a record for each of the at least one graphical icon part in a graphical format.

Miller et al. teaches transmitting messages that include graphical image. (column 1, lines 38-70)

It would have been obvious to an artisan at the time of the invention to include Miller's teaching with method of Deluca and Mochizuki in order to allow users to transfer image files. (see Miller; column 1, lines 31-35)

As per claim 19, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 16. Sugio further teaches wherein the message editor application allows the user to copy a pre-stored graphical Icon from a memory associated with the controller and containing a plurality of clip art graphical icons. (see Sugio, column 6, lines 27-42 and column 7, lines 48-52)

As per claim 20, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 16. Sugio further teaches the communication terminal comprising a message reader application for automatically converting a received compound message into a displayable format based on the text part and the at least one graphical icon pant. (see Sugio, column 9, lines 7-22).

As per claim 21, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 19. Sugio further teaches the method wherein the message reader application includes means for allowing the user to store the at least one graphical part in the memory associated with the controller and containing a plurality of graphical icons. (see Sugio, column 6, lines 27-34)

As per claim 22, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 16. Sugio further teaches wherein the message editor application allows the user to manually generate a graphical icon on the display by selectively marking dots in an icon matrix. (see Sugio, column 17, lines 36-43)

As per claim 23, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 22. Sugio teaches wherein the message editor application allows the user to store a manually entered graphical icon In the memory associated with the controller and containing a plurality of graphical icons. (see Sugio, column 18, lines 29-35)

As per claim 24, Sugio, Mochizuki, and Miller teach a communication terminal claim 16. Sugio further teaches wherein the message editor application allows the user to input a plurality of graphical parts In the graphical part of the message and information in the message to display the plurality of graphical parts as an animation sequence. (see Sugio, column 42, lines 19-22)

As per claim 25, it is rejected with the same rationale as claim 16. Supra

As per claim 30, it is rejected with the same rationale as claim 16. Supra

As per claim 33, which is dependant on claim 30, it is of the same scope as claim 19. Supra.

As per claim 34, which is dependant on claim 30, it is of the same scope as claim 20. Supra.

As per claim 35, which is dependent on claim 30, it is of the same scope as claim 21. Supra.

As per claim 36, which is dependent on claim 30, it is of the same scope as claim 22. Supra.

As per claim 37, which is dependent on claim 30, it is of the same scope as claim 23. Supra.

As per claim 38, which is dependent on claim 30, it is of the same scope as claim 24. Supra

As per claim 41, which is dependent on claim 16, Sugio, Mochizuki, and Miller teach a communication terminal claim 16. Mochizuki further teaches wherein the position information further defines the position of the at least one graphical icon part relative to the text part such that at least a portion of the text is position prior to the at least one graphical icon part and at least another portion of the text part is position following the at least one graphical icon part. (see Mochizuki, figure. 9 (a-d), column 5, lines 6-20)

As per claim 42, which is dependent on claim 25, it is of the same scope as claim 41. Supra.

As per claim 44, which is dependent on claim 30, it is of the same scope as claim 41. Supra.

As per claim 47, which is dependent on claim 16, Sugio, Mochizuki, and Miller teach method of claim 16. Miller further teaches at least one graphical icon part comprises at least one of an image or a picture. (see Miller; column 1, lines 31-35)

As per claims 48 and 50, they are of the same scope as claim 47.

As per claim 53, which is dependent on claim 16, Sugio, Mochizuki, and Miller teach method of claim 16. Sugio further teaches at least one graphical icon part comprises an animatin sequence. (see Sugio, column 42, lines 19-22)

As per claims 54 and 56, they are of the same scope as claim 53.

Claims 17, 18, 26, 27, 28, 31, and 32 rejected under 35 U.S.C. 103(a) as being unpatentable over Sugio et al. US 6,032,025 in view of Mochizuki US 6,044,248 further in view of Miller US Patent 6,421,707 further in view of Medina US 6,047,828.

As per claim 17, Sugio, Mochizuki, and Miller teach a communication terminal according to claim 16. However, Sugio, Mochizuki, and Miller do no teach wherein the message generated by the controller includes the position information. Medina teaches wherein a message includes a header part including position information of graphics. (see Medina, column 3, lines 34-66) It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Sugio, Mochizuki, and Miller with the method Medina in order to allow image data and text data to be properly reconstructed into their proper special relationships

As per claim 18, Sugio, Mochizuki, Miller and Medina teach a communication terminal according to claim 17. Medina teaches wherein the header part of the message furthermore includes information about graphics size. (see Medina, column 3, lines 34-66)

As per claim 26, Sugio, Mochizuki, Miller and Medina teach a communication terminal according to claim 17. Sugio teaches wherein the message editor application allows the user to copy a pre-stored graphical icon from a memory associated with the controller and containing a plurality of clip art graphical icons. (see Sugio, column 6, lines 27-42 and column 7, lines 48-52)

As per claim 27, Sugio, Mochizuki, Miller and Medina teach a communication terminal according to claim 18. Sugio teaches wherein the message editor application allows the user to copy a pre-stored graphical icon from a memory associated with the controller and containing a plurality of clip art graphical icons. (see Sugio, column 6, lines 27-42 and column 7, lines 48-52)

As per claim 28, which is dependent on claim 17, it is of the same scope as claim 18. Supra

As per claim 31, which is dependent on claim 30, it is of the same scope as claim 17. Supra

As per claim 32, which is dependent on claim 31, it is of the same scope as claim 18. Supra

Response to Argument

Applicant's arguments filed on 3/21/07 have been fully considered but they are not persuasive.

Applicant's argument focused on the following:

1) There is no motivation to combine Miller's teaching with the method of Deluca and Mochizuki; and they fail to teach inserting the image with in the text of the message.

2) There is no motivation to combine Miller's teaching with the method of Sugio and Mochizuki.

Examiner disagrees.

1) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, Supreme Court has held that "often, it will be necessary... to look to interrelated teachings of multiple patents; the effect of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known element in the fashion claimed by the patent at issue." KSR Int'l. Co., v. Teleflex, Inc.

In this case, there is a problem with Deluca's compound messaging system and that is its assumption that both the sender and receiver have the required graphical icon for the message that is being transmitted. Miller's teaching solves this problem because when the receiver does have the required graphical icon, the icon can be sent along with the message. (see Miller; column 1, lines 31-35) Therefore, it would have been obvious to one of the ordinary skill in art to combine these two references.

Furthermore, Mocizuki teaches embedding the icon with the text. (column 4, lines 63- column 5,lines 8)

2) In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, Supreme Court has held that "often, it will be necessary... to look to interrelated teachings of multiple patents; the effect of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known element in the fashion claimed by the patent at issue." KSR Int'l. Co., v. Teleflex, Inc.

In this case, there is a problem with Sugio's compound messaging system and that is its assumption that both the sender and receiver have the required graphical icon for the message

that is being transmitted. Miller's teaching solves this problem because when the receiver does

have the required graphical icon, the icon can be sent along with the message. (see Miller;

column 1, lines 31-35) Therefore, it would have been obvious to one of the ordinary skill in art to

combine these two references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peng Ke whose telephone number is (571) 272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L. Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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